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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,253	04/20/2004	Yasuo Suzuki	252164US0DIV	2401

22850 7590 12/02/2004

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

CHAPMAN, MARK A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/827,253

Applicant(s)

SUZUKI ET AL.

Examiner

Mark A. Chapman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11-15-04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/090,745.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04202004
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I, claims 1-8 in the reply filed on 11-15-04 is acknowledged. The traversal is on the ground(s) that there is no additional burden to search additional inventions and that there are insufficient reasons that the groups are patentably distinct. This is not found persuasive because there would be a serious burden on the Examiner to search coating compositions and electrophotographic apparatus and the groups have been shown to be patentably distinct because of the other known uses of coating liquids not used for electrophotographic applications.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11-15-04.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami (5,561,022). Nogami teaches an electrophotographic photoconductor with an intermediate layer that contains carboxylic acid, titanium oxide, and solvent (claims). It would have been obvious to one of ordinary skill in the art to use any suitable amounts of carboxylic acid, titanium oxide, and solvent because of the same desired use as a coating liquid and one would expect similar results from amounts as suggested by Nogami (col. 5-6 and examples).

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay (5,525,440). Kay teaches a coating liquid that contains carboxylic acid, titanium oxide, and solvent (col. 2 line 56 – col. 3 line 11). It would have been obvious to one of ordinary skill in the art to use any suitable amounts of carboxylic acid, titanium oxide, and solvent because of the same desired use as a coating liquid and one would expect similar results from amounts as suggested by Kay. The intended use limitation “for an intermediate layer of an electrophotographic photoconductor” is deemed to be capable of performing a function and therefor not a positive limitation. As shown by Kay, the liquid is used as a coating and it would be capable of performing in the claimed manner.

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The recitation of a new intended use for an old product does not make claim to that old product patentable (In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

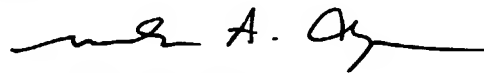
7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter (4,484,949). Potter teaches a coating liquid that contains carboxylic acid, titanium oxide, and solvent (claims). It would have been obvious to one of ordinary skill in the art to use any suitable amounts of carboxylic acid, titanium oxide, and solvent because of the same desired use as a coating liquid and one would expect similar results from amounts as suggested by Potter. The intended use limitation "for an intermediate layer of an electrophotographic photoconductor" is deemed to be capable of performing a function and therefor not a positive limitation. As shown by Potter, the liquid is used as a coating and it would be capable of performing in the claimed manner. The recitation of a new intended use for an old product does not make claim to that old product patentable (In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Chapman whose telephone number is 571-272-1381. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Mark A. Chapman", with a stylized flourish at the end.

Mark A. Chapman  
Primary Examiner  
Art Unit 1756

MC